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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/855,568	05/14/2001	Kenneth J. Ross	006969027710	1531

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EXAMINER

GART, MATTHEW S

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 11/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/855,568

Applicant(s)

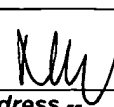
ROSS, KENNETH J.

Examiner

Matthew s Gart

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) 36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 May 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 1/31/2 9/3/2.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Claim 36 was withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 10/4/2004.

Drawings

This application has been filed with informal drawings, which are acceptable for examination purposes only. Figures 3-10 contain improper text, which may affect clarity when reproduced.

Applicant is required to submit a formal correction of the noted defect. Applicant is required to submit drawing corrections promptly. Drawing objections may no longer be held in abeyance.

Claim Rejections - 35 USC §101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-30 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Referring to claims 1-30. The invention as recited in the claims is merely an abstract idea that is not within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter.

Mere recitation in the preamble (i.e., intended use) or mere implication of employing a machine or article of manufacture to perform some or all of the recited steps does not confer statutory subject matter to an otherwise abstract idea. "A method for servicing a request for delivery of an item or A method for delivering a package to a customer." mere nominal use of a component, albeit within the technological arts, does not confer statutory subject matter to an otherwise abstract idea if the component does not affect or affect the underlying process.

Claims 1-30 utilize technology in a trivial manner. For example in claim 4, the body of the claim recites that information is received over the Internet.

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However, there is no structural or functional interrelationship between the "Internet" and the method steps.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-2, 4 and 6 are rejected under 35 U.S.C. 102(e) as being anticipated by Yamada U.S. Patent Number 6,336,100.

Referring to claim 1. Yamada discloses a method for servicing a request for delivery of an item, the method comprising:

- Receiving delivery location information from a customer (Yamada: column 4, lines 32-41);
- Using said delivery address information to provide a set of delivery destinations to said customer, said set of delivery destinations being different from an actual address of said customer (Yamada: column 4, lines 32-41);
- Receiving from said customer a selected delivery destination from said set of delivery destinations (Yamada: Fig. 6); and

- Initiating a shipment transaction with a carrier to deliver the item to said customer, including providing said carrier with said selected delivery destination (Yamada: column 5, lines 7-12).

The Examiner notes, as disclosed by Yamada the delivery location information from a customer includes the selection of the customer's home state, followed by the customer's home city. The method of Yamada based on these selections provides a STATION LIST. Several stations appear on the screen as shown in Fig. 6 where the customer selects the most convenient delivery station from said set of delivery stations.

Referring to claim 2. Yamada further discloses a method comprising: providing said customer with an order number associated with the item (Yamada: Figure 11).

Referring to claim 4. Yamada further discloses a method wherein receiving said delivery location information from said customer further comprises receiving said delivery location information from said customer over the Internet (Yamada: column 1, lines 18-45).

Referring to claim 6. Yamada further discloses a method wherein said set of delivery destinations provided to said customer is stored on a server (Yamada: Fig. 1).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 5 and 7-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamada U.S. Patent Number 6,336,100 in view of Kadaba U.S. Patent Number 6,539,360.

Referring to claim 3. Yamada does not expressly disclose a method comprising linking said order number to a carrier tracking number associated with the item. Kadaba discloses a method comprising linking said order number to a carrier tracking number associated with the item (Kadaba: column 6, lines 25-53).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified the system of Yamada to have included the teachings of Kadaba as discussed above because there is a need for a method that easily obtains the latest information on the status of packages, which allows one to plan accordingly prior to receiving a package (Kadaba: column 4, lines 10-19).

Referring to claim 5. Yamada discloses a method according to claim 1 as indicated supra. Yamada further discloses a method of receiving delivery location information from said customer through a computer browser. Neither

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Yamada nor Kadaba discloses receiving said delivery location information from said customer through an interactive voice response system.

However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The receiving of delivery location information from said customer would be performed the same regardless of the customer interface. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F. 2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to receive delivery location information from said customer through a plurality of interface types because such interface type does not functionally relate to the steps in the method claimed.

Referring to claim 7. Kadaba further discloses a method comprising: providing package-tracking information to said customer relating to said item through the Internet (Kadaba: column 6, lines 25-53).

Referring to claim 8. Yamada discloses a method according to claim 1 as indicated supra. Yamada further discloses a method of providing package tracking information to said customer relating to said item through a computer browser. Neither Yamada nor Kadaba discloses a method of providing package tracking information to said customer relating to said item through an interactive voice response system.

However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The providing of

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package tracking information to the customer would be performed the same regardless of the interface. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F. 2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to provide package tracking information to the customer through a plurality of interface types because such interface type does not functionally relate to the steps in the method claimed.

Referring to claim 9. Kadaba further discloses a method comprising: receiving package status information from said carrier relating to delivery of said item to said customer (Kadaba: column 6, lines 25-53).

Referring to claim 10. Kadaba further discloses a method comprising: providing said package status information to said selected delivery destination (Kadaba: column 6, lines 25-53).

Referring to claim 11. Kadaba further discloses a method comprising: receiving arrival information from the selected delivery destination indicating when the item arrives at the selected delivery destination and storing said arrival information on a server (Kadaba: column 6, lines 25-53).

Referring to claim 12. Kadaba further discloses a method comprising: receiving information from said selected delivery destination indicating that said item has been damaged (Kadaba: column 2, lines 43-59 and column 3, lines 32-40).

Referring to claim 13. Kadaba further discloses a method comprising: receiving information from said selected delivery destination indicating that said item has been lost (Kadaba: column 2, lines 43-59 and column 3, lines 32-40).

Referring to claim 14. Yamada discloses a method for servicing a request for delivery of an item, the method comprising:

- Providing a set of delivery destinations to a customer, the delivery destinations not including a home or business address of the customer (Yamada: column 4, lines 32-41) and
- Receiving from the customer a selected delivery destination from the set of delivery destinations (Yamada: column 4, lines 32-41).

Kadaba discloses a method for servicing a request for delivery of an item, the method comprising:

- Receiving package status information from a carrier chosen to deliver the item to the customer, the package status information relating to the delivery of the item (Kadaba: column 3, lines 32-40); and
- Receiving package arrival information from the selected delivery destination indicating when the item arrives at the selected delivery destination.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified the system of Yamada to have included the teachings of Kadaba as discussed above because there is a need for a method that easily obtains the latest information on the status of packages,

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which allows one to plan accordingly prior to receiving a package (Kadaba: column 4, lines 10-19).

Referring to claims 15-25. Claims 15-25 are rejected under the same rationale as set forth above in claims 1-13.

Referring to claim 26. Yamada discloses a method for delivering a package to a customer, the method comprising:

- Providing a set of delivery destinations to a carrier that comprise alternatives to delivering the package directly to the customer (Yamada: column 4, lines 32-41).

Kadaba discloses a method for delivering a package to a customer, the method comprising:

- Receiving package arrival information from a selected one of the delivery destinations indicating the package has been delivered by the carrier to the selected delivery destination (Kadaba: column 3, lines 32-40); and
- Receiving package pickup information from the selected delivery destination indicating that the package was picked up by the customer (Kadaba: column 3, lines 32-40).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified the system of Yamada to have included the teachings of Kadaba as discussed above because there is a need for a method that easily obtains the latest information on the status of packages, which allows one to plan accordingly prior to receiving a package (Kadaba: column 4, lines 10-19).

The Examiner notes, even though Yamada in view of Kadaba discloses all the limitations of claim 26 as indicated supra, the indicated package arrival information and indicated package pickup information are only found in the nonfunctional descriptive material and is not functionally related to the method steps. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F. 2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983).

Referring to claims 27-30. Claims 27-30 are rejected under the same rationale as set forth above in claims 1-13.

Referring to claim 31. A package delivery system, comprising:

- A first server in electronic communication with a second server, a first client, and a second client operated by a carrier chosen to deliver a package to a customer (Yamada: column 4, lines 32-41); and
- Wherein the first server provides a set of delivery destinations to the second server that comprise alternatives to delivering the package directly to the customer (Yamada: column 4, lines 32-41),

Kadaba discloses a package delivery system wherein the first server receives package status information (Kadaba: column 3, lines 32-40).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified the system of Yamada to have included the teachings of Kadaba as discussed above because there is a need for a system that easily obtains the latest information on the status of packages,

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which allows one to plan accordingly prior to receiving a package (Kadaba: column 4, lines 10-19).

Referring to claims 32-35. Claims 32-35 are rejected under the same rationale as set forth above in claims 1-13.

Examiner's Comments

Examiner cites particular columns and line numbers in the references as applied to the claims for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

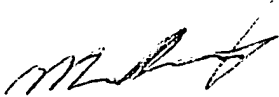
Stolfo et al., Patent Application Publication US 2004/002903 A1, Jan. 1, 2004, discloses the electronic purchase of goods over a communications network including physical delivery while securing private and personal information of the purchasing party.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew s Gart whose telephone number is 703-305-5355. The examiner can normally be reached on 8:30AM to 5:00PM m-f.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 703-308-1344. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to be 'MSG', is located above the typed name.

MSG
Patent Examiner
November 7, 2004